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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,561	02/05/2004	William Jabs	RID10038P0020US	5510
32116	7590	07/20/2005	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			FULLER, BRYAN A	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/772,561

Applicant(s)

JABS, WILLIAM

Examiner

Bryan A. Fuller

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 12 is/are pending in the application.
- 4a) Of the above claim(s) 7 - 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 6, drawn to a method of cementing the annulus of an oil or gas well, classified in class 166, subclass 253.1.
  - II. Claims 7 - 12, drawn to a product capable of cementing the annulus of an oil or gas well, classified in class 106, subclass 712.
2. The inventions are distinct, each from the other because:
3. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used for measuring and testing other fluid systems.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Allen Hoover on 7/14/2005 a provisional election was made with traverse to prosecute the invention of Group I claims 1 - 6. Affirmation of this election must be made by applicant in replying to this Office action.

Art Unit: 3676

Claims 7 - 12 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

6. The abstract of the disclosure is objected to because the title is just ABSTRACT. The title of the abstract should be -- ABSTRACT OF THE DISCLOSURE --. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 4: The language, "selected from dyes or pigments conventionally used to colour concrete," is indefinite.

With respect to claim 6: The language, "selected from dyes conventionally used to colour concrete," is indefinite.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3676

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 – 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallus (4,452,638) in view of Smith et al (5,120,367).

With respect to claims 1 – 3, and 5: Gallus teaches in column 3, lines 22 – 56 a method of cementing the annulus of an oil or gas well having a casing centering within a hole bored from a surface, the method comprising the steps of introducing an effective amount of colouring agent into a water-based separating fluid, pumping said water-based separating fluid ahead of a cementing slurry down the casing to the bottom of the hole to displace drilling mud upwardly through the annulus to the surface, until the colouring agent becomes visible at the surface, displacing the casing volume and then stopping the pumping and allowing the pumped cement slurry to harden. The reference also teaches a method wherein the water-based separating fluid is a spacer or scavenger fluid. Finally, Gallus teaches a method wherein the dye is selected from the group comprising carbon black, iron oxide, phthalocyanine, umber, chromium oxide, titanium oxide, and cobalt blue. Examiner notes that Smith et al also teaches the various colouring agents in column 5, lines 24 – 28.

Gallus does not teach the use of a water-soluble bag, made of polyvinyl alcohol, as a container for the colouring agent, as the means for introducing the colouring agent into the fluid. Smith et al teaches in column 7, lines 17 – 28 a method where a water-soluble bag, made of polyvinyl alcohol, is used as a container for the colouring agent and as a means for introducing the colouring agent into the fluid. Therefore, it would

Art Unit: 3676

have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gallus's invention by using a water-soluble bag, made of polyvinyl alcohol, as a container for the colouring agent and as a means for introducing the colouring agent into the fluid in view of Smith et al. The motivation for this combination is that the use of a water-soluble bag, as a means of introducing the colouring agent, allows for a powdered solid admixture to be added or dispensed expediently, economically and accurately.

### ***Conclusion***


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Poolen (3,417,824) and Billings et al (3,273,643) both teach the use of a water-soluble bag made of polyvinyl alcohol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan A. Fuller whose telephone number is (571) 272-8119. The examiner can normally be reached on M - Th 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian E. Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Glessner  
Supervisory Patent Examiner  
Art Unit 3676

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